

EA



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,128	01/07/2002	Clifford A. Pickover	YOR9200100372US1	3989
48175	7590	07/19/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 07/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/041,128	<b>Applicant(s)</b> PICKOVER ET AL.	
	<b>Examiner</b> Rob Rhode	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1- 33, 35 – 56 and 58, drawn to a method and system for electronic shopping with receiving instructions, classified in class 705, subclass 26.
- II. Claims 34, 57 and 59, drawn to a method and system for electronic shopping with issuing instructions, classified in class 705, subclass 27.

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group I has a different function regarding a method and system for electronic shopping with receiving instructions, which does not include issuing instructions. Claim 1 for example, does not require a method and system for electronic shopping, which includes issuing instructions to impart patentable distinction to the method recited therein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Species***

***In the event the applicant elects Group I above, the applicant is further obligated to elect among the following species as follows:***

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I a. Species of claims 1, 2, 3, 20, 21, 29 and 58
- I b. Species of claims 1, 2, 4, 5, 20, 21, 29 and 58
- I c. Species of claims 1, 2, 4, 6, 20, 21, 29 and 58
- I d. Species of claims 1, 2, 7, 20, 21, 29 and 58
- I e. Species of claims 1, 2, 8, 20, 21, 29 and 58
- I f. Species of claims 1, 2, 9, 20, 21, 29 and 58
- I g. Species of claims 1, 2, 10, 20, 21, 29 and 58

Art Unit: 3625

- I h. Species of claims 1, 2, 12, 20, 21, 29 and 58
- I i. Species of claims 1, 2, 13, 20, 21, 29 and 58
- I j. Species of claims 1, 2, 14, 20, 21, 29 and 58
- I k. Species of claims 1, 2, 15, 20, 21, 29 and 58
- I m. Species of claims 1, 2, 16, 20, 21, 29 and 58
- I n. Species of claims 1, 2, 17, 20, 21, 29 and 58
- I o. Species of claims 1, 2, 18, 20, 21, 29 and 58
- I p. Species of claims 1, 2, 19, 20, 21, 29 and 58
- I q. Species of claims 1, 22 and 23 and 58
- I r. Species of claims 1, 22 and 24 and 58
- I s. Species of claims 1, 25 and 58
- I t. Species of claims 1, 26 and 58
- I u. Species of claims 1, 27 and 58
- I v. Species of claims 1, 28 and 58
- I w. Species of claims 1, 30 and 58
- I x. Species of claims 1, 31 and 58
- I y. Species of claims 1, 32 and 58
- I z. Species of claims 1, 33 and 58
- I a' Species of claims 1, 2, 3, 35, 36 and 37 and 58
- I b' Species of claims 1, 2, 4, 5, 35, 36, 38 and 39 and 58
- I c' Species of claims 1, 2, 4, 6, 35, 36, and 40 and 58
- I d' Species of claims 1, 2, 7, 35, 36 and 41 and 58

- I e' Species of claims 1, 2, 8, 35, 36 and 42 and 58
- I f' Species of claims 1, 2, 9, 35, 36 and 43 and 58
- I g' Species of claims 1, 2, 10, 35, 36 and 44 and 58
- I h' Species of claims 1, 2, 11, 35, 36 and 45 and 58
- I i' Species of claims 1, 2, 12, 35, 36 and 46 and 58
- I j' Species of claims 1, 2, 13, 35, 36 and 47 and 58
- I k' Species of claims 1, 2, 35, 36 and 48 and 58
- I m' Species of claims 1, 2, 35, 36 and 49 and 58
- I n' Species of claims 1, 2, 16, 35, 36 and 50 and 58
- I o' Species of claims 1, 2, 17, 35, 36 and 51 and 58
- I p' Species of claims 1, 2, 18, 35, 36 and 52 and 58
- I q' Species of claims 1, 2, 19, 35, 36 and 53 and 58
- I r' Species of claims 1, 2, 35, 36 and 54 and 58
- I s' Species of claims 1, 2, 35, 36 and 55 and 58
- I t' Species of claims 1, 2, 35, 36 and 56 and 58

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic for Group I; Claim 34 is generic for Group II.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.7159**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:


**(703) 872-9306**

[Official communications; including

After Final communications labeled

"Box AF"]

RER



Jeffrey A. Smith  
Primary Examiner